

REMARKS

Claim Rejections

Claims 20-33 are rejected under 35 U.S.C. § 112, second paragraph. Claims 20-33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown et al. (U.S. 6,100,208) in view of Roe et al. (U.S. 5,834,381).

Claim Amendments

By this Amendment, Applicant has canceled claims 25-30 and has amended claim 20 of this application. It is believed that the new claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

In response to the Examiner's § 112 rejections, Claim 20 has been amended to no longer recite a knitted fabric as a subset of a woven fabric.

Claim 20 has been amended to include the limitation of canceled claim 28. Claim 20 now recites, *inter alia*, "a middle layer of a woven fabric coated with a water proof and air permeable polyurethane **resin**." (*Emphasis added*)

The primary reference to Brown et al. teaches a non-woven first outer layer (12), a non-woven middle barrier layer (16) including a water impervious layer, and a non-woven or woven second outer layer (14). As admitted by the Examiner on p. 2 of the most recent Office Action, Brown et al. "does not specifically teach employing a woven or knitted layer in conjunction with the center barrier."

It follows that Brown does not teach a middle layer of a woven fabric coated with a water proof and air permeable polyurethane resin.

The secondary reference to Roe et al. teaches a non-halogenated trilaminate fabric and is cited for teaching a knitted or woven fabric scrim (14). Roe teaches a trilaminate fabric having a reinforced fabric scrim 14 sandwiched between an upper and lower thermoplastic olefin film 12. It is important to note that Roe only teaches laminate **films** and fails to teach anything about coating the fabric scrim 12 with a water proof and air permeable polyurethane **resin**. See, generally, Col. 3, l. 9-Col. 4, l. 58.

It follows that Roe et al. do not teach or suggest a middle layer of a woven fabric coated with a water proof and air permeable polyurethane resin. Furthermore, Roe et al. do not teach the upper layer is water repellant and air permeable; nor do Roe et al. teach a middle layer of a woven fabric coated with a water proof and air permeable material.

Even if the teachings of Brown et al. and Roe et al. were combined, as suggested by the Examiner, the resultant combination does not suggest: a middle layer of a woven fabric coated with a water proof and air permeable polyurethane resin.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be

non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

It is important to note that, as compared with the prior art's use of films to coat fabric, only Applicant has recognized the superior qualities of coating a middle layer with polyurethane resin. Namely, a resin will absorb into the fabric threads and partially fill the spaces therein. In comparison, the prior art's films are laminated to the fabric which inevitably results in air pockets between the fabric and the film. These air pockets are quick to fail and, as a result, allow water to pass through fabric.

Applicant submits that there is not the slightest suggestion in either Brown et al. or Roe et al. that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Brown et al. nor Roe et al. disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art

Application No. 10/673,412

to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's new claims.

Summary

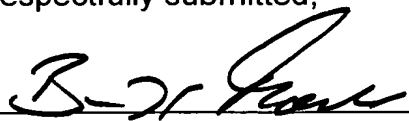
In view of the foregoing, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should the Examiner not be of the opinion that this case is in condition for allowance, it is requested that this amendment be entered for the purposes of appeal, since it materially reduces the issues on appeal by obviating the outstanding the rejection of claims 25-30 under 35 U.S.C. § 112, second paragraph and under 35 U.S.C. § 103(a). It is not believed that the foregoing amendments require any further searching and/or consideration on the part of the Examiner, since such amendment merely combine previously searched claims.

Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

Date: May 14, 2006

By:


Bruce H. Troxell
Reg. No. 26,592

TROXELL LAW OFFICE PLLC
5205 Leesburg Pike, Suite 1404
Falls Church, Virginia 22041
Telephone: 703 575-2711
Telefax: 703 575-2707

CUSTOMER NUMBER: 40144